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In re Application of :
KUPPENHEIMER, John :
Application No.: 10/553,822 :
PCT No.: PCT/US04/05812 :
Int. Filing Date: 26 February 2004 :
Priority Date: 24 April 2003 :
Attorney Docket No.: 20030022 :
For: SINGLET OR STABILIZING BTS BY :
USING E1 TRUNK BOARD :
DUPLEXING OF BSC :

DECISION ON PETITION

This decision is issued in response to applicant's "Request to Correct Filing Receipt" filed 11 May 2007. Applicant requests a corrected filing receipt which indicates the first inventor as John D. Kuppenheimer and lists the filing (or 371) date as 20 October 2005. Additionally, this application is before the Office Of PCT Legal Administration for issues arising under 35 U.S.C. 371. No petition fee is required.

BACKGROUND

On 26 February 2004, applicants filed international application PCT/US04/05812 which claimed a priority date of 24 April 2003. The published international application identified two applicant/inventors for the United States: John Kuppenheimer and William F. Wing. The deadline for submission of the basic national fee was thirty months from the international filing date, i.e., 24 October 2005.

On 20 October 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 08 December 2006, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 20 December 2006, applicants submitted a declaration executed by inventor

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William Wing and Robert Kuppenheimer, on behalf of inventor, John Kuppenheimer.

On 24 April 2007, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 20 December 2006. Subsequently, an Official Filing Receipt was issued indicating a "FILING DATE" of 20 December 2006.

On 11 May 2007, applicants filed "Request to Correct Filing Receipt."

DISCUSSION

A. *Issues Arising Under 35 U.S.C. 371*

A review of the application file and other United States Patent and Trademark Office records reveals that the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not been completed as indicated in the Notification of Acceptance mailed by the DO/EO/US on 24 April 2007. Specifically, the oath or declaration requirement under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America has not been properly executed under 37 CFR 1.497 and 37 CFR 1.42. As such, the Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 24 April 2007, based as they were on applicant's purported submission of an acceptable declaration under 37 CFR 1.497, are appropriately vacated.

B. *Submission Under 37 CFR 1.42*

As noted above, the declaration was not executed by inventor John Kuppenheimer. Instead, the declaration was executed on his behalf by "Robert Kuppenheimer (executor)." Apparently, applicant John Kuppenheimer is deceased.

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration submitted on 20 December 2006 was executed by William F. Wing and Robert Kuppenheimer as "executor" to the deceased inventor, John Kuppenheimer. The declaration is executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or

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declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative (executor). The declaration filed on 20 December 2006 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the executor or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

C. Filing (or 371) Date

Applicants are reminded that the actual filing date of the present application is considered to be the international filing date, 26 February 2004. The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage are completed (see MPEP §1895.01).

The name of the first inventor has been corrected to JOHN Kuppenheimer in the USPTO Palm database.

CONCLUSION

The submission under 37 CFR 1.42 is **DISMISSED** without prejudice. The Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 24 April 2007 are hereby **VACATED**.

Applicants have **TWO (2) MONTHS** from the mailing date of this Decision to submit a proper response under 37 CFR 1.42. Failure to provide a proper and timely response will result in abandonment. A proper response must include an acceptable declaration executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the deceased inventor's heirs. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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